

REMARKS

The present application was filed on December 15, 2003 with claims 1-33. Claims 1, 10, 16, 29 and 31-33 are the independent claims.

In the outstanding Office Action, the Examiner rejects claims 1-33 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 6,091,765 to Pietzold, III et al. (hereinafter "Pietzold").

In this response, Applicants respectfully traverse the rejection for at least the following reasons.

Regarding the §102(b) rejection of claims 1-33, Applicants respectfully assert that Pietzold fails to teach or suggest all of the limitations in claims 1-33, for at least the reasons presented below.

It is well-established law that a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Applicants assert that the rejection based on McGarvey does not meet this basic legal requirement, as will be explained below.

The present invention, for example, as recited in independent claim 1, recites a method of preconditioning a computer-controllable device. The method comprises determining at least one anticipated context with which the device may be associated, and determining at least one mode of operation associated with the at least one anticipated context such that the at least one mode of operation may be effectuated before or at a time when the anticipated context is at least partially realized.

By way of example only, the present specification (at page 7, lines 4-27), the invention may precondition a software defined radio (SDR)-enabled device to configure its SDR dynamically as its operational context changes during, for example, the course of a day. For example, the invention considers the possibility in which the SDR-enabled device may be expected to be used in the same location for multiple purposes and it would thus be advantageous for the device to be preconditioned to allow its operation for such purposes. For instance, an SDR-enabled cellular phone may be used for both business and personal purposes, and for each purpose a different carrier, carrier plan, and carrier technology may have to be utilized. Based on, for example, the phone number called, the SDR-enabled phone may select the appropriate carrier, carrier plan, and carrier technology to use.

This may be made possible by making the collection of necessary configuration parameters already available in the SDR-enabled device so as to allow the device to make a selection among these parameters based on locally and dynamically derived criteria, e.g., the number to which a call is placed. This, in turn, may be made possible by the SDR-enabled device, and/or a provider service for configuration parameters, anticipating the collection of potential context situations and corresponding operational modes that the device may encounter during, e.g., the course of a day, and making available the appropriate SDR configuration parameters to the device in advance. Thus, advantageously, principles of the invention may precondition a device based on past history, phone plan subscriptions, the set of applications that may be run and the requirements that they impose on the underlying communications network, external network conditions and so on.

Applicants respectfully disagree with the Examiner with regard to claim 1 as being anticipated by Pietzold. Specifically, Applicants respectfully disagree that Pietzold discloses the concepts of “preconditioning” and “anticipated context.” Both of these terms apply to events or conditions that are expected in the future. Both of these terms refer to action/operations occurring at the present time in preparation (preconditioning) of operational modalities that the device will experience at some future time (anticipated context). For example, FIG. 2 of the present application contains an extensive, yet not exhaustive, collection of anticipated contexts 200 that can be considered.

In contrast, Pietzold discloses a configurable device that operates “in current” time. As column 5, lines 55-60, explains, the device in Pietzold responds to instructions provided by the user to configure its current operational mode. In particular, the configuration is specifically responsive to current or currently desired operational conditions. This user-initiated operation does not contain any element of preconditioning or anticipation.

Furthermore, Pietzold refers exclusively to the radio subsystem of a single device (see claim 1 in column 45, lines 36-67). The entire disclosure of Pietzold discloses exclusively how input from a user effectuates the configuration of the radio subsystem in response to immediate needs or conditions. The invention is about the entire device, and even though used in illustrative embodiments, the device is not required to contain a configurable radio subsystem. Any one (or a combination of) computer-controlled part(s) of the device in the invention is allowed to be

preconditioned and have its operation effectuated based on anticipated context. That is, the invention may be applicable not only to the SDR in a device, but to its communication subsystem in general, its input/output modality capabilities, display fonts, and so on.

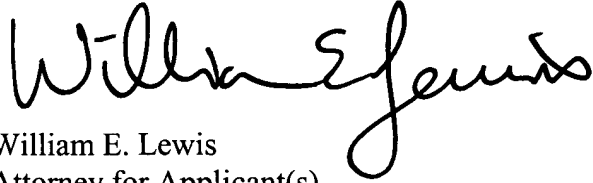
Finally, Pietzold discloses of a device that reacts in response of instructions provided through the user input module 26 that is used “for selecting the transmitter and receiver modes of operations and for selecting the communications signaling system” of a “field configurable radio frequency communications system” (see Pietzold at claim 1, column 45, lines 36-37 and 53-56). The invention does not require input by the user to effectuate the configuration of the device in the field. Because in the invention, the device is preconfigured based on anticipated context, the device can change its mode of operation without user intervention. Modes of operation can change automatically whenever the device senses the existence of at least one of the anticipated context, e.g., switch service plans between the same or different service providers based on time of day. The latter may not require change of radio modulation techniques because the service plans could operate by a provider or providers that use the same radio modulation technique, as Pietzold discloses at column 1, lines 51-53.

Based on the above, Applicants believe that claim 1 is allowable. Also, since independent claims 10, 16 and 31-33 recite the concept of “projected” or “anticipated” context, and claim 29 recites the concept of “a target of communication,” Applicants believe that such claims are also allowable.

Regarding the claims that depend from the various independent claims, Applicants assert that such claims are patentable not only due to their respective dependence on such claims, but also because such claims recite patentable subject matter in their own right.

In view of the above, Applicants believe that claims 1-33 are in condition for allowance, and respectfully request withdrawal of the §102(b) rejection.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "William E. Lewis". The signature is fluid and cursive, with the first name "William" being more prominent than the last name "Lewis".

Date: January 5, 2006

William E. Lewis
Attorney for Applicant(s)
Reg. No. 39,274
Ryan, Mason & Lewis, LLP
90 Forest Avenue
Locust Valley, NY 11560
(516) 759-2946